IN THE

# Supreme Court of the United States

October Term, 1943.

No.....

LEROY J. LEISHMAN,

*Petitioner,*

*vs.*

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

*Respondent.*

## BRIEF IN SUPPORT OF PETITION.

### I.

### Publication of Opinions of Lower Courts.

The opinion in the District Court [R. Vol. I, pp. 19 *et seq.*] is reported in 36 Fed. Supp. 804.

The first opinion in the Circuit Court of Appeals [R. Vol. IV, pp. 684 *et seq.*] is reported in 128 F. (2d) 204.

The first opinion of the Supreme Court is reported in 63 S. Ct. 543.

The second opinion of the Circuit Court of Appeals [R. Vol. V, pp. 700 *et seq.*] is at this writing yet unreported.

## II.

### Basis of Jurisdiction.

1. The judgment of the District Court was entered on May 1, 1941 [R. Vol. I, pp. 38 *et seq.*].

2. The decree of the Circuit Court of Appeals to be reviewed was entered on August 12, 1943 [R. Vol. V, pp. 717 *et seq.*].

3. The statute under which jurisdiction is invoked is Section 240 of the Judicial Code; 28 U. S. Code, paragraph 347.

4. The United States Circuit Court of Appeals for the Ninth Circuit applied the reasoning of *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra,* in a manner that conflicts with the Circuit Court of Appeals for the Second Circuit, in *Monogram Mfg. Co. v. Glemby Co., Inc., et al., supra.*

5. The Circuit Court of Appeals for the Ninth Circuit has ruled in a manner inconsistent with *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra.*

6. The Circuit Court of Appeals for the Ninth Circuit has also misapplied the decision in *Altoona Publix Theatres v. American Tri-Ergon Corp., supra.*

## III.

### Statement of the Case.

The case has already been stated in the preceding petition under the heading: "Statement of the Matter Involved," and is hereby adopted and made a part of this brief.

## IV.

### Specification of Errors.

1. The Circuit Court of Appeals for the Ninth Circuit misapplied the ruling in *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra,* to form a basis for the opinion that the reissue claims 7-11 do not cover a leverless combination.

2. The Circuit Court of Appeals for the Ninth Circuit misapplied the ruling in *Altoona Publix Theatres v. American Tri-Ergon Corp., supra,* to form a basis for its opinion that a disclaimed claim must be ignored when considering the matter of the intent of petitioner to cover a leverless combination.

3. The Circuit Court of Appeals for the Ninth Circuit erred in interpreting claims 7 and 8, as necessarily including a lever, although the combination defined in these claims does not include any element that could even be construed as the equivalent of the lever.

## V.

### Argument.

That a conflict in the decisions of two Circuit Courts of Appeals forms a sufficient basis for granting this petition is stated in Rule 38, paragraph 5 (b), of this Honorable Court.

In the interpretation of claims of a reissue patent, a serious question is presented. This Honorable Court has held in the *U. S. Industrials* case that, where an element is stressed as essential in the original patent, the reissue claims omitting the step are invalid.

In the instant case, the Ninth Circuit Court of Appeals does not depend at all upon any statement in the original patent that the lever is an essential; nor can it do so, for no such statement can be found in the patent. In fact, many statements in the patent indicate the contrary. Instead, that Court substitutes an incomplete and therefore wrong test—whether or not the *claims* of the original patent included levers.

The Court of Appeals, under its erroneous interpretation of this Honorable Court's decision in the *U. S. Industrial Chemicals* case could have come to a conclusion concerning the validity of the reissue patent. But, instead of so doing, the Court utilizes its erroneous evaluation of what the patentee intended to claim to determine that the accused device does not infringe. The attempted extension of this Honorable Court's decision in the *U. S. Industrial Chemicals* case, to serve as a guide for interpreting the scope of a reissue patent notwithstanding the language of its claims, is clearly unwarranted. All of the reissue claims 7-11 are clearly broad enough to cover a plunger operated device.

The Circuit Court of Appeals had to take two other steps to attempt justification of its decision. One was the holding that claim 5 of the original patent need not be considered on the question of intent to claim an invention. This is an incorrect extension of that branch of the law of disclaimers that is discussed in *Altoona Publix Theatres v. American Tri-Ergon Corp., supra.*

In this latter decision, this Honorable Court considered whether a qualifying disclaimer served to qualify a claim as of the date of the patent, or otherwise. It was held that the claim was qualified as of the date of the patent. In

*Dunbar v. Myers, supra,* as well as in *Oliver Machinery Co. v. Gellman, supra,* and *Schwarzwalder v. New York Filter Co., supra,* the Court simply pointed out the obvious effect of disclaimers on the construction of the patent in determining the question of infringement. But this certainly is no authority that the claims as written may not be used to determine the intentions of the patentee. And especially is this the case since claim 5 appeared as such in the reissue along with disputed claims 7-11.

If *Altoona Publix Theatres v. American Tri-Ergon Corp.* is to be interpreted to mean that a claim disclaimed from a reissue must be considered for *all* purposes as if it had never been in the original patent, then a claim appearing in the original but *omitted* from a reissue must also be so considered. If original claims omitted from a reissue cannot be taken into consideration in comparing the two documents and in trying to determine the true scope of the invention, then original patents *all* of whose claims have been omitted from the reissue must be considered as having had no scope at all—as being in fact, for inventions that the patents could never cover. If original claims that do not appear identically in the reissue cannot be taken into account at all, then such matters as broadened reissues or narrowed reissues must be done away with, as there will be no basis for determining them.

When properly considered as a part of the original patent, claim 5, which does not include a lever, definitely establishes that petitioner did not consider a lever essential to all embodiments of his invention, and it shows that he realized that the "simple manually operated control" and "the single manual operation" mentioned repeatedly in the objects could be effected by any suitable means.

The Circuit Court of Appeals, after it has taken the first step of deciding that the claims at issue must include a lever, then takes the concluding step—that the plunger is not an equivalent of the lever [R. Vol. V, p. 716], on the ground that the lever performs a double function [footnote 17, R. Vol. V, p. 715], that of operating both tappets 61 and 62. The Court ignores the fact that one of the objects of the invention recited [R. Vol. III, p. 509] in the patent in issue is "to make it possible for a single manual operation to tune either a radio set or a television set, or both; . . ." Therefore, it was understood that either one or both tappets 61 and 62 may be used.

But to be an equivalent, it is not necessary that the plunger perform *all* of the functions of the lever. See, for example, *Hobbs v. Beach,* 180 U. S. 383, at page 401:

> "The fact that the Horton device contains no mechanism for turning the strip into the inside of the corner, merely indicates that it does not perform all the functions of the Beach patent. But it is no less an infringement if it performs its primary function in practically the same way."

To permit the decision of the Ninth Circuit Court to stand uncorrected would invite serious misapplications of the law of reissue patents; for it would sanction the notion that claims added by a reissue must contain every element mentioned in any and all claims of the original, and that every element must be limited to the specific form described in the patent, even though such element is not stressed as essential in the original.

## Conclusion.

It is respectfully submitted that the manifest errors appearing in the opinion of the Circuit Court of Appeals in its application of the law of reissues are compelling for the grant of this petition; and especially since the opinion is in conflict with a Second Circuit decision.

Respectfully submitted,

LeRoy J. Leishman,

By John Flam,

*Counsel for Petitioner.*